

Appl. No. 09/821,953
Atty. Docket No. 7973MR
Resp. dated February 10, 2006
Reply to Non-Compliant Amdt. dated January 31, 2006

REMARKS

Claims 38-42, 65-71, 74-83, 85-111 are now in the case.

Applicants have amended claim 38 to include the features of a cleaning sheet that does not include any additional layer of fibrous material.

Each of these amendments is supported by the specification, claims and drawings as filed.

Rejections under 35. U.S.C. 103

Claims 38-42, 65-70 and 95-98

Independent claim 38 has been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Lerner *et al.* '292 in view of Ngai '627 for reasons of record at paragraph 3 of the Office Action dated February 10, 2005.

The Office Action asserts that "claim 38 uses 'comprising' language when referring to the cleaning sheet, so other layers may be present."

Applicants respectfully disagree.

Claim 38 includes the feature of a macroscopically three-dimensional substrate consisting essentially of a single layer of nonwoven material having a first outward surface and a second outward surface. (emphasis added)

Applicants submit that if, as suggested by the Office Action, an additional layer were to be added to the cleaning sheet by applying an additional layer against a single layer of nonwoven material, this single layer of nonwoven material would not include a first and a second outward surface as presently claimed.

In addition, Applicants submit that claim 38 has been amended to include the features of a cleaning sheet which does not include any additional layer of fibrous material. (emphasis added)

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The Office Action also asserts that "the transitional phrase 'consisting essentially of' limits the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention. So the substrate may still contain other layers, so long as the basic and novel characteristics of the claimed invention are not affected."

Applicants respectfully disagree.

Independent claim 38 included the feature of "a macroscopically three-dimensional substrate consisting essentially of a single layer of nonwoven material having a first outward surface and a second outward surface wherein said cleaning sheet does not include any additional layer of fibrous material." (emphasis added).

As best understood by Applicants, the Ngai reference used in the Office Action discloses that "[t]he method of the invention generally comprises the steps of forming a first non-woven web ... An additional step comprises forming a second non-woven web ... A final step comprises laminating the first and second webs together to form the non-woven composite of the invention." (emphasis added, see Ngai Col 3, lines 17-26)

Assuming, *arguendo*, that the first non-woven web discussed in Ngai were a macroscopically three-dimensional substrate, Applicants submit that the addition by lamination of a second web to the first web as required by Ngai, would not only prevent the first web from having a first and a second outward surface but it would also contradict the feature of a cleaning sheet which does not include any additional layer of fibrous material as presently claimed in claim 38.

As a result, it is Applicants' position that Ngai teaches away from the claimed invention.

Furthermore, Applicants submit that it is basic patent law that "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation ... to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure." *In re Vaeck*, 947 F.2d 488, USPQ 2d 1438 (Fed Cir. 1991). (emphasis added)

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As the Ngai reference requires at least two webs laminated to each other, Ngai does not teach or suggest a cleaning sheet comprising a macroscopically three-dimensional substrate consisting essentially of a single layer of nonwoven material having a first outward surface and a second outward surface wherein said cleaning sheet does not include any additional layer of fibrous material.

Consequently, it is Applicants' position that the Office Action fails to establish a *prima facie* case of obviousness.

The Office Action also asserts that "[w]ith regard to the Average Height Differential of at least about 0.5mm for the peaks and valleys and claims 65 and 66, Ngai discloses transferring a pattern from a forming support, and specifically recites U.S. Patent No. 5,098,764 to Drelich *et al.* for an example of usable forming support. Drelich *et al.* disclose the forming support to have a height differential from peak to valley of 0.229 cm. Since the material is molded to the same shape as the forming support, the average height differential of the Ngai substrate would be at least 1.5 mm." (emphasis added).

Applicants submit that the Office Action recites what appears to be contradicting positions.

Since Drelich discloses a nonwoven substrate including a plurality of holes or openings along with the forming support used to produce this substrate, and since Ngai only refers to the transfer of a pattern from a forming support, either Ngai would not have enabled one of ordinary skill in the art to make a substrate without the apertures or openings resulting from the use of the Drelich forming support as taught by Drelich, or the Examiner is taking Official Notice of this knowledge.

Applicants note that Ngai does not disclose what is meant by "transferring a pattern from a forming support."

The Office Action asserts that "the material is molded to the same shape."

The Office Action did not provide any documentary evidence supporting that the material can be molded to the same shape as the forming support.

"Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." MPEP 2144.03

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Reconsideration and withdrawal of the rejection are therefore respectfully requested for claims 38-42, 65-70 and 95-98.

Claims 77-83, 85-94 and 99-102

Independent claim 90 and dependent claims 77-83, 85-79, 91-93 and 99-102 have been rejected for the reasons of record at paragraph 3 of the Office Action dated February 10, 2005.

Applicants remind the Examiner that "[to] establish a *prima facie* case of obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP 2143.03

Independent claim 90 includes the features of a non-apertured layer having a first outward surface and a second outward surface, wherein at least one of said outward surfaces has a macroscopic three dimensional texture including a non-random macroscopic pattern including discrete raised regions and recessed regions wherein said outward surface including said non-random macroscopic pattern has an Average Height Differential of at least about 0.2 mm and a polymeric additive selected from the group consisting of pressure sensitive adhesive, tacky polymer, and mixtures thereof, wherein said polymeric additive is incorporated onto said substrate at a level of from about 0.1 g/m² to about 10.0 g/m². (emphasis added).

Applicants submit that none of the references used in the rejection teaches or even remotely suggests a non-apertured layer having a first outward surface and a second outward surface, a non-random macroscopic pattern pattern including recessed regions and discrete raised regions and a polymeric additive incorporated onto the substrate at a level of from about 0.1 g/m² to about 10.0 g/m².

Moreover, Applicants' submit that the Office Action selectively chooses individual portions of the Lerner and Ngai references without providing any reason as to why one of ordinary skill in the art would have been motivated to selectively combine some of the prior art disclosure in order to recreate the claimed invention.

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Applicants remind the Examiner that “[w]hen applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (1) The claimed invention must be considered as a whole; (2) the reference must be considered as a whole and must suggest the desirability and thus the obviousness of making the contribution; (3) the reference must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and (4) reasonable expectation of success is the standard with which obviousness is determined.” (emphasis added) *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187, n.5 (Fed. Cir. 1986)., MPEP 2141.

It is well settled patent law that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the invention as a whole would have been obvious.” *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed Cir. 1983). MPEP 2141.02

“Distilling an invention down to a ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole.’ *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851 (1984) MPEP 2141.02

It is Applicants’ position that by dissecting the claimed invention into individual elements and analyzing individually the obviousness of each of these separate elements in view of the prior art, the Office Action did not consider the invention as a whole and as a result, the Office Action has failed to establish a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejection are therefore respectfully requested for claims 77-83, 85-94 and 99-102.

Claims 95-111

Claims 95-111 have been rejected under 35 U.S.C. 103 (a) as being allegedly unpatentable over Lerner *et al.* in view of Ngai and further in view of Bhattacharjee *et al.*

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For the record, Applicants submit that currently, claims 95-98 depend directly or indirectly on independent claim 38, claims 99-102 depend directly or indirectly on independent claim 90 and that claims 104-111 depend directly or indirectly on independent claim 103.

The Office Action asserts that "Bhattacharjee *et al.* teach that sufficient cleaning is attained when a pattern of tacky adhesive is applied to a cleaning substrate rather than a continuous coating. It would have been obvious to a person having ordinary skill in the art at the time of the invention to create a cleaning cloth with at least one zone not possessing the coating in order to save on the amount of coating used while creating a substrate with sufficient cleaning ability."

Applicants respectfully disagree.

Applicants note that Lerner *et al.* disclose that "[t]he tackifier, adhesive and slip agent form a continuous coating on the fibers of the cloth." (See Abstract) "The entangled web, while it is still wet, is thoroughly impregnated with the pressure sensitive adhesive and tackifier to create the unique cloth." (See Col 5, lines 67-68 and Col 6 line 1) "The wet hydro-entangled fabric assists in wicking the pressure-sensitive adhesive throughout the entire cloth." (See Col 6, lines 9-11)

Applicants submit that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to render the claim *prima facie* obvious." *In re Patti*, 270 F.2d. 810, 123 USPQ 349 (CCPA 1959) MPEP 2143.02

It is Applicants' position that since the Lerner *et al.* reference requires that the cloth be thoroughly impregnated with a tacky composition, one of ordinary skill in the art would have no motivation whatsoever to apply a coating of a tacky composition in zones as asserted by the Office Action.

As best understood by Applicants, it appears that the Office Action is attempting to find a source of motivation to modify Lerner *et al.* in the need "to save on the amount of coating being used."

Assuming *arguendo* that, as suggested by the Office Action, one skilled in the art would have been motivated to save on the amount of coating being used by modifying Lerner *et al.* (who

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require a tacky composition uniformly applied to a cloth), the skilled person would have reduced the amount of tacky composition impregnated in the cloth rather than applying the same amount in zones.

Clarification on the above point is respectfully requested.

Moreover, Applicants submit that the Office Action did not consider the claimed invention as a whole and did not consider the prior art references as a whole.

It is well accepted patent law that "...when we examine the obviousness of a composition of matter claim, it is the invention as a whole, and not some part of it, which must be obvious under 35 U.S.C. 103." *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977)

It is Applicants' position that the Office Action only considered part of the claimed invention in view of the prior art instead of considering the claimed invention as a whole and, as a result, it is Applicants' position that the Office Action has failed to establish a prima facie case of obviousness.

Reconsideration and withdrawal of the rejection are therefore respectfully requested for claims 95-111.

It is submitted that all the claims are in condition for allowance. Early and favorable action on all claims is therefore requested.

If the next action does not allow the claims, the favor of a telephonic interview is requested with the undersigned representative.

Respectfully submitted,
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